

REMARKS

Claims 1-4 were examined and reported in the Office Action. Claims 1-4 are rejected. Claims 1-4 are amended. New claims 8-10 are added. Claims 1-4 and 8-10 remain.

Applicant requests reconsideration of the application in view of the following remarks.

I. 35 U.S.C. § 103(a)

It is asserted in the Office Action that claims 1-4 are rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over U. S. Patent No. 4,946,288 issued to Siska et al. (“Siska”). Applicant respectfully traverses the aforementioned rejection for the following reasons.

According to MPEP §2142

[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that ‘rejections on obviousness cannot be sustained with mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.’ *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Further, according to MPEP §2143, “[T]he Supreme Court in *KSR International Co. v. Teleflex, Inc.* 550 U.S. ___, ___, 82 USPQ2d 1395-1397 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper “functional approach” to the determination of obviousness as laid down in *Graham*.” Further, according to MPEP §2143.01, [o]bviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006). Further, “[t]he

mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” *KSR International Co. v. Teleflex, Inc.* 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007).

Additionally,

[a] statement that modification of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Pat. App. & Inter. 1993).

Applicant’s minute projections are formed on the mirror surface in order to provide nuclei that serve to promote dew condensation or frost formation there. Such minute projections formed on the mirror surface make it tend to have an increased possibility of dew condensation even at lower dew points to improve the response at such lower dew points. Further, Applicant’s claimed invention has a remarkable advantage that is unexpected in Siska in that the sizes of condensed dew drops are made unlikely to change with a change in the flow rate of the measurement target gas, and the equilibrium of dew condensation is made less unlikely to break, therefore improving the measurement accuracy.

Although Siska discloses a roughened surface portion on the mirror surface, this roughened surface is formed in order to improve the sensitivity of hydrocarbon dew point detection, but not for the detection sensitivity of moisture or water vapor dew point. In Siska the way the water vapor dew point is determined using only a highly reflecting surface portion (highly polished mirror surface) of a mirror surface is clearly different from Applicant’s claimed invention, in which a combination of the mirror surface with the minute projections promoting dew condensation is used.

Further, it seems that Siska describes an example in which the hydrocarbon is caused to fill the pits and valleys of the roughened surface in order to increase the sensitivity of hydrocarbon dew point detection. Applicant’s claimed invention, however, differs from Siska in that Siska resorts to such pits and valleys of the mirror surface as above.

Moreover the assertions made in the Office Action on pages 2-3 that lead to a conclusion of obviousness are not explicit and the basic requirements of an articulated rationale under MPEP 2143 cannot be found. And, since Siska does not teach, disclose or suggest all the limitations of Applicant's amended claim 1, as listed above, Applicant's amended claim 1 is not obvious over Siska in view of no other prior art since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that directly or indirectly depend from amended claim 1, namely claims 2-4 and 8-9, would also not be obvious over Siska in view of no other prior art for the same reason.

Additionally, according to Applicant's new claim 10, since the minute projections are formed using a photoresist and an etching process, the minute projections are formed with a substantially same shape at a substantially same interval (with a same density) on the mirror surface. This makes it possible to readily configure and form the minute projections at high accuracy and thus to provide a highly accurate mirror surface of stable quality having minute projections. In contrast, Siska does not teach any method for forming the roughened surface other than mere a sand blasting process. With such a sand blasting process, it is difficult to form pits and valleys evenly and uniformly on a mirror surface and thus difficult to fabricate a mirror surface having stable quality for a dew point analyzer. Further, if someone tries to form such minute projections as in the claimed invention by using a sand blast process, it is difficult to form the minute projections with a substantially same shape at a substantially same interval (with a same density) on the mirror surface.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejections for claims 1-4 are respectfully requested.

CONCLUSION

In view of the foregoing, it is submitted that claims 1-4 and 8-10 patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN LLP

Dated:

1/17/08

By:

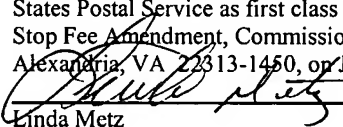


Eric S. Hyman, Reg. No. 30,139

1279 Oakmead Parkway
Sunnyvale, California 94085-4040
(310) 207-3800

CERTIFICATE OF MAILING:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on January 17, 2008.


Linda Metz

1-18-08
January 18, 2008